

**REMARKS**

In response to the Office Action dated November 12, 2004, Applicant's undersigned representative respectfully requests reconsideration based on the above claim amendments and the following remarks. Applicant's undersigned representative respectfully submits that the claims as presented are in condition for allowance.

Claims 1 through 16 are pending in this application. Claims 1, 2, 7, 9, and 13 through 15 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent 6,779,021 (Bates et al.). Claims 3, 4, and 11 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Bates in view of U.S. Patent 6,643,687 (Dicke et al.). Claims 5, 8, 10, and 12 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bates in view of U.S. Application Publication 2002/0116641 (Mastrianni). Claim 6 is rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Bates in view of U.S. Patent 6,266,692 (Greenstein). Claim 16 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bates in view of U.S. Patent Application Publication 2001/0027474 (Nachman).

**Interview Summary**

On January 27, 2005, Applicant's undersigned representative conducted a telephonic interview with Examiner Nguyen. During that interview, the Bates reference was discussed in connection with various features of the pending claims. Examiner Nguyen agreed to consider arguments for patentability upon submission of a written response.

Applicant's undersigned representative wishes to thank Examiner Nguyen for conducting the telephonic interview and for his continued consideration of the present application.

**November 4, 2004 Information Disclosure Statement**

On November 4, 2004, an Information Disclosure Statement (IDS) was submitted in connection with this application. An initialed copy of the IDS has not been received. Submitted herewith is a copy of the previously submitted IDS. An initialed copy is respectfully requested.

**Rejections**

Claim 1 is directed to a method of regulating e-mail, comprising:

**maintaining profile information for a plurality of registered e-mail sources that have registered to forward e-mail to a destination, said profile information comprising for each registered e-mail source statistics regarding e-mails previously received from the registered e-mail source;**  
**maintaining category information for a plurality of e-mail source categories, said category information comprising for each e-mail source category statistics regarding e-mails previously received from the e-mail source category;**  
receiving an e-mail;  
identifying an e-mail source for the e-mail;  
determining from the profile information if the e-mail source is a registered source;  
**if the e-mail source is a registered source,**  
**updating the profile information maintained for the e-mail source to reflect receipt of the e-mail,**  
**comparing the profile information for the e-mail source to target e-mail statistics, and**  
**if the profile information for the e-mail source is not acceptable in comparison to the target e-mail statistics,**  
**taking a remedial action; and**  
**if the e-mail source is not a registered source,**  
**identifying one of said plurality of e-mail source categories,**  
**updating the category information for the identified e-mail source category to reflect receipt of the e-mail,**  
**comparing the category information for the identified e-mail source category to target e-mail statistics,**  
**and**  
**if the category information for the identified e-mail source category is not acceptable in comparison to the target e-mail statistics, taking a remedial action.**

In order for a reference to anticipate this claim, the reference must teach all of the claimed features, including those emphasized. Independent claims 10, 13, and 14 comprise similar features. Applicant's undersigned representative respectfully submits that none of the cited references teach or suggest the claimed features.

Bates is directed to a system and method for predicting undesirable electronic mail. In the system disclosed by Bates, when an email is received at the server, the e-mail is compared to an inclusion list of persons from whom e-mails are expected. (Col. 8, ll. 37-45). If the e-mail is received from a source identified in the inclusion list, the e-mail is placed in the appropriate e-mail folder for review by the user. (Col. 10, ll. 24-26). If the e-mail is not in the inclusion list, the e-mail may go through a number of filters including determining whether the number of e-mails received from the e-mail source exceeds a predetermined time period, the e-mail is identified as spam.

In contradistinction to the claimed subject matter, however, Bates does not teach:

- maintaining profile information for a plurality of registered e-mail sources that have registered to forward e-mail to a destination, said profile information comprising for each registered e-mail source statistics regarding e-mails previously received from the registered e-mail source;

- maintaining category information for a plurality of e-mail source categories, said category information comprising for each e-mail source category statistics regarding e-mails previously received from the e-mail source category;

- if the e-mail source is a registered source,

- comparing the profile information for the e-mail source to target e-mail statistics, and

- if the profile information for the e-mail source is not acceptable in comparison to the target e-mail statistics, taking a remedial action; and

- if the e-mail source is not a registered source, identifying one of said plurality of e-mail source categories,

- comparing the category information for the identified e-mail source category to target e-mail statistics, and

- if the category information for the identified e-mail source category is not acceptable in comparison to the target e-mail statistics, taking a remedial action.

Indeed, Bates does not teach maintaining profile information for a plurality of registered e-mail sources that have registered to forward e-mail to a destination, and certainly does not teach maintaining category information for a plurality of e-mail source categories.

Therefore, Bates cannot possibly teach if the e-mail source is a registered source, comparing

the profile information for the e-mail source to target e-mail statistics, and if the profile information for the e-mail source is not acceptable in comparison to the target e-mail statistics, taking a remedial action, as set forth in the independent claims. Likewise, Bates cannot possibly teach if the e-mail source is not a registered source, identifying one of said plurality of e-mail source categories, comparing the category information for the identified e-mail source category to target e-mail statistics, and if the category information for the identified e-mail source category is not acceptable in comparison to the target e-mail statistics, taking a remedial action, as set forth in the independent claims. Therefore, independent claims 1, 10, 13 and 14 are considered allowable over Bates. Claims 2-9, 11-12, and 15-16 depend from claims 1, 10, and 14, respectively, and are considered allowable for at least the same reasons.

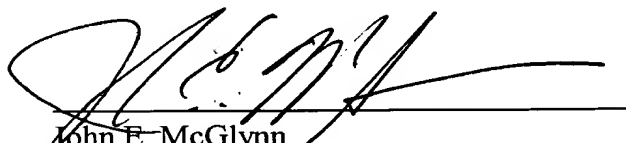
With regard to dependent claims 3-6, 8, 10-12 and 16, the Office Action points to various combinations of Bates with Dickie, Mastrianni and Greenstein to show the claimed features. Dickie, Mastriannie, and Greenstein fail to make up for the deficiencies of Bates as to the features of independent claims 1, 10, and 14. Therefore, claims 3-6, 8, 10-12, and 16 are considered allowable over any combination of these documents.

Therefore, because the references fail to teach or even suggest elements of the claimed combination, withdrawal of the prior art rejections is respectfully requested.

### **CONCLUSION**

For all of the foregoing reasons, Applicants' undersigned representative requests reconsideration of the outstanding Office Action and issuance of a Notice of Allowance.

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John E. McGlynn  
Registration No. 42,863

Woodcock Washburn LLP  
One Liberty Place - 46th Floor  
Philadelphia PA 19103  
Telephone: (215) 568-3100  
Facsimile: (215) 568-3439